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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,768	02/07/2002	Edmund Ming Kwan	PA2354US	1636

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EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/071,768

Applicant(s)

KWAN, EDMUND MING

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, 14-16 and 31-37 are rejected under 35 U.S.C. 101 because the claimed method for collaboration solutions does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998). The independently claimed steps of creating a list of partners, creating an invitee list and issuing credit to the clients are abstract ideas which can be performed mentally without interaction of a physical structure or are mere data storage devices that do not implement a useful, concrete and tangible result of a machine. Because the independently claimed invention is directed to an abstract idea which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-9, 11-14, 20-31 and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanzillo, Jr. et al. (US 2002/0032602) in view of Crosskey et al. (US 6,035,281).

Lanzillo, Jr. et al. teach a system and method for recipient selection and message delivery, comprising:

As per claim 1, 9 and 17,

- a first module for developing new and maintaining existing partner lists ([0042]; [0043]; [0081]);

- a second module for developing new and maintaining existing invitee lists ([0042]; [0043]; [0081]);

- a third module for merging invitees' information with invitation templates to generate invitations ([0043]; [0068]);

- a fourth module for generating invitations via electronic mail to all invitees ([0041]);

- a fifth module for updating subscription information that is accessible by clients on-line ([0048]; [0056]; [0081]);

- a sixth module for generating electronic messages of reminders to urge unresponsive invitees to come to a subscription conclusion ([0043]; [0048]; [0056]).

Lanzillo, Jr. et al. do not teach a seventh module for calculating credit earned generated by external revenue to offset subscription fees incurred by usage of host solutions by the client.

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Crosskey et al. teach a system and method for multiparty billing for web access wherein credits to the clients are issued to offset against subscription fees (column 3, lines 47-53; column 6, lines 18-19; column 8, line 66 through column 10, line 40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lanzillo, Jr. et al. to include issuing credits to the clients to offset against subscription fees because it would make it more attractive to the customers thereby generating more revenue.

As per claims 3-6, 8 and 16, Lanzillo, Jr. et al. teach said system and method wherein the clients have the flexibility of deciding which partners to invite to become subscribers ([0042]; [0043]; 0081]).

As per claim 7, Crosskey et al. teach said system and method wherein the list of partners changes as a collaboration environment of the client changes (column 3, lines 47-61).

As per claim 11, Lanzillo, Jr. et al. teach said system and method wherein the system is configured to track those who decline subscriptions ([0043]; [0048]; [0056]).

As per claim 12, Lanzillo, Jr. et al. teach said system and method wherein the system is configured to receive subscribers' credit card information ([0068]).

As per claim 12, Lanzillo, Jr. et al. teach said system and method wherein the sixth module is configured to repeatedly generate electronic messages of reminders until a pre-determined percentage of all invitees have come to a subscription decision, wherein the client can readjust the predetermined percentage ([0043]; [0048]; [0056]; [0068]).

As per claim 14, Crosskey et al. teach said system and method, comprising: setting, based on a pre-determined formula, an external revenue goal for a client; offering the external revenue

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goal to the client; and attempting by the client to earn credit to completely offset subscription fees charged by a service provider (column 3, lines 47-53; column 6, lines 18-19; column 8, line 66 through column 10, line 40).

As per claim 18, 21-22, 24-28, 31 and 36, Crosskey et al. teach said system and method, comprising: a third module for calculating subscription fees, including those incurred by partners who did not buy subscriptions, that have not been paid for; and a fourth module for billing a client for subscription fees that have not been paid for (column 3, lines 47-53; column 6, lines 18-19; column 8, line 66 through column 10, line 40).

As per claims 20 and 23, Crosskey et al. teach said system and method wherein the system is configured to track subscription fees that are at least partially contributed by the partners for using hosted enterprise solutions (column 3, lines 27-53; column 6, lines 18-19; column 8, line 66 through column 10, line 40).

As per claims 29 and 37, Crosskey et al. teach said system and method wherein the cost-sharing system is configured to track cost-sharing among subscribers, non-subscribers and clients (column 3, lines 27-53; column 6, lines 18-19; column 8, line 66 through column 10, line 40).

As per claims 30 and 33-34, Crosskey et al. teach said system and method wherein calculating subscription fees includes calculating earned credit generated by external revenue to offset against fees for usage of a hosted enterprise solution (column 3, lines 27-53; column 6, lines 18-19; column 8, line 66 through column 10, line 40).

As per claim 35, Crosskey et al. teach said system and method wherein the subscription fee is at least partially contributed by the non-subscribers for using hosted enterprise solutions (column 3, lines 27-53; column 6, lines 18-19; column 8, line 66 through column 10, line 40).

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Claims 2, 10, 15, 19 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanzillo, Jr. et al. and Crosskey et al. in view of Fitser et al. (US 5,631,904).

As per claims 2, 10, 15, 19 and 32, Lanzillo, Jr. et al. and Crosskey et al. teach all the limitations of claims 2, 10, 15, 19 and 32, except that the method of cost-sharing is offered to a client as an option.

Fitser et al. teach a system and method for automatically establishing a conference call to a preselected list of prospective participants, wherein a payment option includes sharing of the cost for the call (column 5, lines 30-35).

It would have been obvious to one having ordinary skill in the art to modify Lanzillo, Jr. et al. and Crosskey et al. to include that the method of cost-sharing is offered to a client as an option because it would enhance the versatility of the system thereby making it more attractive to the customers.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

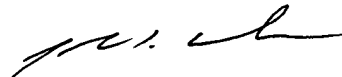
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*Commissioner of Patents and Trademarks  
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or faxed to:

**(703) 305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.



**JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
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